

Remarks

In response to the Office Action dated March 3, 2004, assignee elects the invention of Group I, consisting of claims 46-55, with traverse as explained below.

First, assignee disagrees with the statement in the Office Action that the two inventions are "unrelated" (by which assignee assumes the Examiner means "independent"). Under MPEP 806, two inventions are "independent" where there is "no disclosed relation therebetween." Per MPEP 808.01, independent inventions are those that "are not connected in design, operation, or effect under the disclosure of the particular application under consideration This situation ... is but rarely presented, since persons will seldom file an application containing disclosures of independent things." Examples given in MPEP 806.04 of "independent" inventions are (1) a shoe and a locomotive bearing; (2) a process of painting a house and a process of boring a well.

Here, according to the disclosure, the invention of Group I (claim 46 et seq.) is a process of making a filter. The invention of Group II (claim 67 et seq.) is a process of filtering water, which uses a filter such as the one made by the process of Group I. Thus, the disclosure explains the relatedness of the two inventions.

To assist the Office in recognizing the relatedness of the two inventions, assignee has added a third independent claim, directed to the product in question, as claim 78, with dependent claims 79-83. Assignee believes that claim 78 (and its dependent claims) links the two groups. The Examiner can see that claim 78 defines the product made by the process of claim 46 (Group I). Unlike previously restricted claim 25, product claim 78 requires irregular macroscopic copolymer fragments. Further, the filter of claim 78 (or the

structure of dependent claim 79) is used in the process of filtering claimed by claim 67 (Group II).

The situation now presented falls under 37 CFR 1.141(b) and MPEP 806.05(i). The rule specifies: "If the process of making [here claims 46-55] and the product [claims 78-83] are not distinct, the process of using [claims 67-77] may be joined with the claims directed to product [claims 78-83] and the process of making the product [claims 46-55] even though a showing of distinctness between the product [claims 78-83] and process of using the product [claims 67-77] can be made." The MPEP recognizes this situation as presenting related inventions.

In a proper restriction analysis, once the relatedness of the inventive groups is recognized, the Office must decide (under the above-quoted rule) whether the invention of Group I (claim 46), the process of making, is distinct from new claim 78, the product made. In judging that question, the Examiner should consider whether the process of making is an obvious process of making the product, whether the process of making can be used to make other and different products, and whether the product can be made by another and materially different process. *See* MPEP 806.05(f).

If the Examiner concludes that the process of making is non-obvious and the filter can be made by other means, despite the parallel limitations used in the three independent claims, then the Examiner should maintain the restriction requirement and accept assignee's provisional election. Otherwise, the Examiner should reconsider and withdraw the restriction requirement and examine all pending claims, including the ones presented here.

If the Examiner has any questions, please contact assignee's undersigned attorney.

Respectfully submitted,

ABTECH INDUSTRIES, INC.
by its attorney



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